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| 10/015,087 | 10/19/2001 | Leonard Arnold Duffy | | 9503 |

7590 01/10/2007
Leonard Duffy
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| EXAMINER |
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BRITTAIN, JAMES R

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| ART UNIT | PAPER NUMBER |
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3677

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE | DELIVERY MODE |
|--|------------|---------------|
| 3 MONTHS | 01/10/2007 | PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/015,087

Applicant(s)

DUFFY, LEONARD ARNOLD

Examiner

James R. Brittain

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 7-16, 18-23, 25-34, 44-48, 50, 52 and 60-66 is/are pending in the application.
- 4a) Of the above claim(s) 3-5, 7-11, 15, 16, 18-23, 25-32, 45, 46, 52 and 61 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1, 2, 12-14, 33, 50 and 62-66 is/are allowed.
- 6) ☒ Claim(s) 34, 44, 47, 48 and 60 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

Election/Restriction

Claim 1 is directed to an allowable product. Pursuant to the procedures set forth in MPEP § 821.04(B), claim 48, directed to the process of making or using an allowable product, previously withdrawn from consideration as a result of a restriction requirement, is hereby rejoined and fully examined for patentability under 37 CFR 1.104.

Because all process claims previously withdrawn from consideration under 37 CFR 1.142 have been rejoined, **the restriction requirement as set forth in the Office action mailed on September 9, 2004 is hereby withdrawn insofar as directed to the restriction requirement directed to the method of use set forth in the paragraph bridging pages 3 and 4.** In view of the withdrawal of the restriction requirement as to the rejoined inventions, applicant(s) are advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Once the restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. See *In re Ziegler*, 443 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

Claims 1, 12 and 33 are allowable. The restriction requirement among Species I through VII, as set forth in the Office action mailed on September 9, 2004, has been reconsidered in view of the allowability of claims to the elected invention pursuant to MPEP § 821.04(a). **The restriction requirement is hereby withdrawn as to any claim that requires all the limitations of an allowable claim.** Claims 3-5, 7-11, 15, 16, 18-23, 25-32, 45, 46, 52, and 61,

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directed to the non-elected species remain withdrawn from further consideration because they do not all require all the limitations of an allowable generic linking claim as required by 37 CFR 1.141. The withdrawn independent claims need to be rewritten to include all the limitations of an allowable generic claim and if there is a species not covered by an allowable generic claim, then that species cannot be rejoined herein.

In view of the above noted withdrawal of the restriction requirement, applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Once a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. See *In re Ziegler*, 443 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 48 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 defines a “slidably engageable fastening device”. Claim 48 must include the entire subject matter of claim 1 and not redefine “a first portion” (claim 48, line 3), “a first base” (claim 48, line 4) and “a first plurality of first islands” (claim 48, line 5) without directly linking it to the subject matter already in claim 1. It is suggested that claim 48 initially include the step

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“of providing the slidably engageable fastening device of claim 1” or similar language and follow with reference to “said” first or second portions as the case may be.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 34, 44, 47 and 60 are rejected under 35 U.S.C. §103(a) as being unpatentable over Duffy (US 5983467) in view of Allan (US 5640744).

Duffy (figures 1-8) teaches a slidably engageable fastening device operable upon application of a relative shearing force, comprising: a first portion that includes: a first base having a first basal surface; and a plurality of first undercut segments spaced from the first basal surface; and a second portion for slidably engaging with the first portion upon application of a relative shearing force with respect to the first and second portions, the second portion including: a second base having a second basal surface; a plurality of stems each having a first end attached to the second base and a second end distal from the second basal surface; and at least one second undercut segment attached to each of the plurality of stems at the second end and extending away from the each stem, thereby providing a tapered aperture for receiving adjacent pairs of the first undercut segments between adjacent pairs of the stems. The claim construction is such that only one intermediary stem segment can be associated with each second island, not a plurality of stems with each island. Further, the claim construction permits the usual spacing of the second islands and therefore the spacing of adjacent undercut segments from adjacent islands by the

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single stem of each second island. The difference is that the base lacks fenestrations. However, Allan (figure 21) teaches that it is desirable to place fenestrations in the base and located below the undercut segments 136 for ease of attaching to an object by sewing, a common expedient. It would have been obvious to modify the base of the device of Duffy so as to have fenestrations in view of Allan (figure 21) teaching that it is desirable to place fenestrations in the base and located below the undercut segments 136 for ease of attaching to an object by sewing, a common expedient. Applicant is familiar with the teachings of his prior patent and is fully aware of the sliding engagement taught by therein. The placement of apertures in the base is a common expedient for attachment such as that evidenced by Allan and one having ordinary skill in the art would readily recognize the use of apertures for attachment and applicant's patent shows the use of sewing to attach the base to an object. Similarly, with respect to claim 44, this claim construction is such that only one intermediary stem segment can be associated with each second island, not a plurality of stems with each island. Further, the claim construction permits the usual spacing of the second islands and therefore the spacing of adjacent undercut segments from adjacent islands by the single stem of each second island. Claim 44 is therefore rejected for the same reasons as claim 34. As to claims 47 and 60, these limitations are taught by Duffy.

Response to Arguments

The substitute specification of June 27, 2006 has been entered.

Applicant's arguments have been fully considered but they are not persuasive.

In response to applicant's argument that providing fenestrations to the substrate provides enhanced flexibility, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when

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the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). Further, Allan suggests fenestrations in the substrate that would inherently provide enhanced flexibility.

References can be combined for reasons other than applicant's reason and the references the above rejection provides a reason for combining the references.

The claim constructions presented by claims 34, 44, 47 and 60 is broader than applicant's arguments for the reasons given above.

Allowable Subject Matter

Claims 1, 2, 12-14, 33, 50 and 62-66 are allowed.

Conclusion

This action is a **final rejection** and is intended to close the prosecution of this application. Applicant's reply under 37 CFR 1.113 to this action is limited either to an appeal to the Board of Patent Appeals and Interferences or to an amendment complying with the requirements set forth below.

If applicant should desire to appeal any rejection made by the examiner, a Notice of Appeal must be filed within the period for reply identifying the rejected claim or claims appealed. The Notice of Appeal must be accompanied by the required appeal fee of \$250.

If applicant should desire to file an amendment, entry of a proposed amendment after final rejection cannot be made as a matter of right unless it merely cancels claims or complies with a formal requirement made earlier. Amendments touching the merits of the application which otherwise might not be proper may be admitted upon a showing a good and sufficient reasons why they are necessary and why they were not presented earlier.

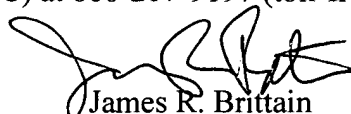
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A reply under 37 CFR 1.113 to a final rejection must include the appeal from, or cancellation of, each rejected claim. The filing of an amendment after final rejection, whether or not it is entered, does not stop the running of the statutory period for reply to the final rejection unless the examiner holds the claims to be in condition for allowance. Accordingly, if a Notice of Appeal has not been filed properly within the period for reply, or any extension of this period obtained under either 37 CFR 1.136(a) or (b), the application will become abandoned.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James R. Brittain whose telephone number is (571) 272-7065. The examiner can normally be reached on M-F 5:30-2:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J. J. Swann can be reached on (571) 272-7075. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


James R. Brittain
Primary Examiner
Art Unit 3677

JRB